

Application No.: 09/700,839

Docket No.: 22135-00006-US

REMARKS**INTRODUCTION**

Receipt of the Office Action dated March 2, 2004 is acknowledged. The present amendment proposes canceling claim 4 without prejudice or disclaimer and incorporating subject matter thereof into claim 1. Claim 5 would be amended to depend on claim 1.

Entry of the present amendment pursuant to 37 CFR 1.116 is respectfully urged as the proposed amendment does not raise any new issue as the amendment merely incorporates previously recited subject matter from a dependent claim into independent claims 1 and 16. No new matter would be added. Furthermore, the instant amendment is believed to place the current application in condition for allowance based on the statements made by the Examiner in the March 2, 2004 Office Action. Entry of the amendment and favorable reconsideration are earnestly solicited. Claims 1-3 and 5-16 will be pending assuming entry of the instant amendment is granted.

THE OFFICE ACTION

Claims 1-16 stand rejected under 35 USC 103 as allegedly unpatentable over DD 247830A in view of Lorcks (US 6,096,809). The Examiner indicates that this rejection is premised on the same reasons set out in section 6 of the July 1, 2003 office action.

The examiner has acknowledged that DD 247830A does not teach or suggest polyesterurethanes or thermoplastic starch. However, the Examiner is apparently of the opinion that because Lorcks mentions thermoplastic starch, "the issue is resolved." Applicants respectfully disagree. Furthermore, claim 1 and claim 16 recite a film wherein the components thereof are in a microdisperse distribution. Both DD 247830A and Lorcks are completely silent with respect to films having such a distribution. The Examiner has taken the position that a microdisperse distribution is an obvious matter of engineering choice, depending on the final properties desired in the casing. And for this proposition, the Examiner has cited In re Peterson,

Application No.: 09/700,839

Docket No.: 22135-00006-US

65 USPQ2d 1379 (Fed.Cir 2003). The Examiner's apparent basis for taking this position is that it was obvious to "use [] *devices that produce better* dispersions, such as microdispersions, of the starch and polyurethane components of the mixtures." (emphasis supplied). However, the Examiner has not cited any basis whatsoever that a microdispersion will produce a *better* dispersion. In the Peterson case cited by the Examiner, the claims were directed to a composition as follows:

A nickel-base superalloy having special utility in the production of single crystal gas turbine engine blades consisting essentially of about 1 to 3 percent rhenium, about 14 percent chromium, about 9.5 percent cobalt, about 3.8 percent tungsten, about 2 percent tantalum, about 1.5 percent molybdenum, about 0.05 percent carbon, about 0.004 percent boron and, respectively, from about 3 to 4.8 percent aluminum, from about 4.8 percent to about 3 percent titanium, and balance substantially nickel.

The examiner rejected the claims under 35 U.S.C. § 103 as obvious over the following 3 prior art references. The examiner asserted the combination of references constituted a *prima facie* case of obviousness based on the overlapping element ranges of the prior art compositions and the claimed composition. So thus, contrary to the instant situation, the references relied upon in Peterson admittedly constituted overlapping ranges; that is, there was a suggestion to make a superalloy as claimed by combining the references. Here, the Examiner admits that none of the references teaches or suggest using a microdispersion, but rather, the Examiner has relied upon alleged obviousness based on what the Examiner believes is a "better" film. Neither of the references teaches or suggests the desirability of using a microdispersion, much less a microdispersion as claimed. Indeed, to the contrary, it was applicants who found that microdispersions of thermoplastic starch and polyurethane are unexpectedly superior to films such as those of the DD reference being relied upon.

In this regard, claim 16 is directed to a film comprising a specific urethane comprising units selected from dihydric alcohols, polyhydric alcohols, dibasic carboxylic acids and polybasic carboxylic acids. Nowhere do either of the references being relied upon teach or suggest such a urethane together with thermoplastic starch in microdispersion to form a film as instantly recited. Thus, favorable reconsideration of claim 16 is respectfully requested.

Application No.: 09/700,839

Docket No.: 22135-00006-US

With respect to instantly amended claim 1, the polyester urethane comprises hard polyurethane segments and soft polyester segments and that these segments are arranged in alternating sequence. It is respectfully submitted that none of the references being relied upon taken alone or in any combination teach or suggest a film as claimed in present claim 1. Namely, DD 247830 discloses a sausage casing including polyurethane which is filled starch. As stated previously in prior responses to the PTO, polyester urethanes are not disclosed or contemplated by the DD. Furthermore, there is no disclosure that the starch could be thermoplastic starch. The process conditions as set forth in the Examples of the DD reference are unsuitable to convert native starch into thermoplastic starch.

The secondary reference, Lorcks, discloses polymer mixtures of thermoplastic starch and polyester urethane (see col. 2, l. 7-23), but is silent about polyester urethanes being specifically segmented, as set forth in present amended claim 1. The film as claimed in claim 1 is hence not in any way suggested by the combination of DD '830 with Lorcks, nor by Mueller et al. which has been labeled in the Office Action as a "Citation of Interest." Namely, Mueller discloses aqueous dispersions of polyurethanes (col. 1, l. 46 et seq.) and hydrophilic polyether alcohols may optionally be employed in minor amounts in the production of the polyurethanes (col. 2, l. 20; component d). There is no motivation provided in the DD, Lorcks or Mueller to arrange the polyurethane and polyether segments in an alternating sequence as instantly recited in claim 1. Thus, claims 1-3 and 5-15 are believed to be allowable for this further reason.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/700,839

Docket No.: 22135-00006-US

Applicant hereby authorizes the Commissioner to please charge our Deposit Account No. 22-0185, under Order No. 22135-00006-US in the amount of \$110.00 for a one month extension of time and for any other fees deemed necessary, from which the undersigned is authorized to draw.

Dated: July 1, 2004

Respectfully submitted,

By Susan E. Shaw McBee

Susan E. Shaw McBee

Registration No.: 39,294

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorney for Applicant